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EXAMINER	
LIU, LIN	

ART UNIT	PAPER NUMBER
2445	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/677,958	SHOCHET ET AL.	
	Examiner	Art Unit	
	LIN LIU	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,24-28,44-47 and 59-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 24-28, 44-47 and 59-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to communications filed on 01/05/2010

Claims 1-7, 24-28 and 44-47 and 59-64 are pending and have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 24-28 are rejected under 35 USC 101 since the claims are directed to non-statutory subject matter.

4. Claims 24-28 recite a computer readable media which appear to cover both transitory and non-transitory embodiments. The United States Patent and Trademark Office (USPTO) is required to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable media (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media **and** transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim*

Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

5. The Examiner suggests that the Applicant add the limitation "non-transitory" to the computer readable media as recited in the claim(s) in order to properly render the claim(s) in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification. The Examiner also suggests that the specification may be amended to include the term "non-transitory computer readable media" (NOTE: when the specification is silent) OR to add the term "non-transitory" to the disclosed computer readable medium in the claims and specification to avoid a potential objection to the specification for a lack of antecedent basis of the claimed terminology.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-7 and 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Applicant has amended claims 1 and 24 to include **"the unique code is not transmissible between the first user and the second user via the multi-user communication environment"** wherein such limitations are not positively recited in the

originally filed specification. Applicant has not specifically pointed out where in the specification, such limitations can be found. The examiner has reviewed paragraphs [0028] and [0041] of the specification, but no support is found. The disclosures from paragraphs [0028] and [0041] of the specification, at most disclose that *the unique code being transmitted between the first user and the second user via a mode outside of the multi-user communication environment.*

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim1-7 and 24-28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Applicant has amended claims 1 and 24 to include "the unique code is not transmissible between the first user and the second user via the multi-user communication environment", which is a negative limitation that rendered the claims indefinite (See MPEP 2173.05 (i) Negative Limitations section).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1-7, 24-28, 44-47 and 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Danieli et al. (Patent no.: US 7,240,093 B1)** in view of **Yamada et al. (PGPUB: US 2002/0049805 A1), Maehiro (PGPUB: US 2002/0062348 A1)** and **Harvey et al. (PGPUB: US 2002/0059379 A1)**.

With respect to **claim 1,** Danieli teaches a method for initiating communication in real-time between users in a multi-user communication environment, the method comprising:

providing an invitation generated by the multi-user communication environment to a first user in the multi-user communication environment (Danieli: fig. 9, col. 9, lines 28-51); and wherein:

the established relationship comprises an association of the invitation with the first user and the second user (Danieli: fig. 9, col. 9, lines 28-51);

the authenticated relationship is established between the first user and the second user in response to receipt by the multi-user communication environment of the acceptance of invitation from the second user; and the invitation is not transmissible between the first user and the second user via the multi-user communication environment (Danieli: col. 9 line 58 to col. 10 line 26 and col. 10, lines 43-53).

However, Danieli does not explicitly teach a method of establishing a communication between users with a menu-driven system of pre-prepared chat messages.

In the same field of endeavor, Yamada teaches a method of establishing a communication between users with a menu-driven system of pre-prepared chat

messages (Yamada: fig. 8-12, page 6, paragraphs 101-104, noted the pre-prepared messages from chat agent).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of establishing a communication between users with a menu-driven system of pre-prepared chat messages as taught by Yamada in Danieli's invention in order to utilize the speech recognition technique for inputting the prompt and saves the users from manually input by hand.

However, the combined method of Danieli-Yamada does not explicitly teach that the invitation comprise of a unique code and a method of authenticating a chat room invitation.

In the same field of endeavor, Maehiro teaches a method that the invitation comprises of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the invitation data format as taught by Maehiro in the combined method of Danieli-Yamada's invention in order to allow the server to efficiently identify the area of the database (Maehiro: page 1, paragraph 14).

However, the combined method of Danieli-Yamada-Maehiro does not explicitly teach a method of enabling free form communication between the first user and a second user in response to establishing the authenticated relationship between the first user and the second user.

In the same field of endeavor, Harvey teaches a method of enabling free form communication between the first user and a second user in response to establishing the authenticated relationship between the first user and the second user (Harvey: fig. 3, page 7, paragraph 66, noted that the invited user is approved by the central controller).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of authenticating a chat room invitation as taught by Harvey in the combined method of Danieli-Yamada-Maehiro's invention in order to enhance network security between users.

With respect to **claim 2,** Danieli teaches the method according to claim 1, wherein the invitation is provided to the first user by the multi-user communication environment (Danieli: fig. 1& 9, col. 5lines 26-46).

However, Danieli does not explicitly teach that the invitation comprise of an unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of an unique code (Maehiro: fig. 5, page 1, paragraphs 11 & 14).

With respect to **claim 3,** Danieli teaches the method according to claim 2, wherein the multi-user communication environment is an online multiplayer gaming environment (Danieli: fig. 1& 9, col. 5lines 26-46).

With respect to **claim 4,** Danieli teaches the method according to claim 1, wherein the unique code is transmitted by the first user to the second user through at least one of an email program, a telephone conversation, a handwritten note, a chat

room program, direct communication, a instant message program, and a facsimile (Danieli: col. 9 line 58 to col. 10 line 26 and col. 10, lines 43-53).

With respect to **claim 5,** Danieli teaches the method according to claim 3, wherein the first user initiates real-time and secure communication with the second user after the unique code is authenticated in the multi-user environment (Danieli: col. 10 line 54 to col. 11 line 15).

However, Danieli does not explicitly teach a method of establishing a communication between users with a menu-driven system of pre-prepared chat messages that corresponds to a gaming function.

In the same field of endeavor, Yamada teaches a method of establishing a communication between users with a menu-driven system of pre-prepared chat messages that corresponds to a gaming function. (Yamada: fig. 8-12, page 6, paragraphs 101-104, noted the pre-prepared messages from chat agent). Same motivation used in claim 1 applies equally as well to claim 5.

With respect to **claim 6,** Danieli teaches the method according to claim 1, wherein the code comprises a sequence of symbols (Danieli: col. 9 line 58 to col. 10 line 26).

With respect to **claim 7,** Danieli teaches the all of the claimed limitations, except that he does not explicitly teach an invitation code comprises a sequence of alpha-numeric symbols.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

With regard to **claims 24-27 and 44-47,** the limitations of these claims are substantially the same as those in claims 1-7. Therefore the same rationale for rejecting claims 1-7 is used to reject claims 24-27 and 44-47. By this rationale **claims 24-27 and 44-47** are rejected.

With respect to **claim 28,** Danieli teaches the computer readable media according to claim 24, wherein the unique code is valid for a limited period of time (Danieli: col. 9, lines 28-57).

With regard to **claims 59-61,** the limitations of these claims are substantially the same as those in claims 1-5. Therefore the same rationale for rejecting claims 1-5 is used to reject claims **59-61**. By this rationale **claims 59-61** are rejected.

With respect to **claim 62,** Danieli teaches all of the claimed limitations except that he does not explicitly teach wherein the pre-prepared chat messages are restricted to a stored library configured to essentially eliminate certain communications between the users.

In the same field of endeavor, Yamada teaches wherein the pre-prepared chat messages are restricted to a stored library configured to essentially eliminate certain communications between the users. (Yamada: fig. 2, page 5, paragraphs 92-93 page 7, paragraph 107). Same motivation used in claim 1 applies equally as well to claim 62.

With respect to **claim 64,** Danieli teaches all of the claimed limitations except that he does not explicitly teach wherein the menu-driven system of pre-prepared chat messages is dynamically updated to reflect game tasks.

In the same field of endeavor, Yamada teaches wherein the menu-driven system of pre-prepared chat messages is dynamically updated to reflect game tasks. (Yamada: page 7, paragraph 107). Same motivation used in claim 1 applies equally as well to claim 63.

14. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Danieli et al. (Patent no.: US 7,240,093 B1)** in view of **Yamada et al. (PGPUB: US 2002/0049805 A1), Maehiro (PGPUB: US 2002/0062348 A1)** and **Harvey et al. (PGPUB: US 2002/0059379 A1)** and further in view of **Goldberg et al. (Patent no.: US 6161082).**

With respect to **claim 63,** Danieli-Yamada-Maehiro-Harvey teaches all of the claimed limitations except that they do not explicitly teach wherein the menu-driven system of pre-prepared chat messages further comprises: a first menu of pre-prepared chat messages provided to a first user in a first language, the first menu of pre-prepared chat messages being associated with identifiers; a second menu of pre-prepared chat messages provided to a second user in a second language, the second menu of pre-prepared chat messages being associated with the identifiers; wherein the program of instructions further comprises: code configured to permit communication between the first user and the second user via association of one or more pre-prepared chat

messages in the first language with one or more pre-prepared chat messages in the second language via the identifiers.

In the same field of endeavor, Goldberg teaches a menu-driven system of pre-prepared chat messages further comprises: a first menu of pre-prepared chat messages provided to a first user in a first language, the first menu of pre-prepared chat messages being associated with identifiers; a second menu of pre-prepared chat messages provided to a second user in a second language, the second menu of pre-prepared chat messages being associated with the identifiers; wherein the program of instructions further comprises: code configured to permit communication between the first user and the second user via association of one or more pre-prepared chat messages in the first language with one or more pre-prepared chat messages in the second language via the identifiers (Goldberg: fig. 2, col. Line 26 to col. 4 line 21).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the features above as taught by Goldberg in the combined method of Danieli-Yamada-Maehiro-Harvey's invention in order to provide a network based language translation system for users communicating in different languages (Goldberg: col. 2, lines 20-29).

Response to Amendment

15. Applicant's arguments with respect to claims 1-7, 24-28, 44-47 and 59-64 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIN LIU whose telephone number is (571)270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Srivastava Vivek can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lin Liu/
Examiner, Art Unit 2445

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2445